

REMARKS

Claims 1, 3, 4, 6-8, 11 and 15-20 will be pending upon entry of the present amendment. Claims 1, 8, 11 and 15-18 are currently amended. Claims 2, 5, 9, 10 and 12-14 are canceled. No new matter has been added.

As an initial matter, the Examiner provided no basis for rejecting or objecting to claim 15. Claim 15 has been restated in independent form, including the limitations of claims 8 and 9 from which it previously depended, and is therefore allowable.

The Examiner rejected claims 1-4, 6 and 7 under 35 U.S.C. § 103(a) as obvious over Weitkamp (EP-1101934 A) in view of Boyer (U.S. Patent No. 6,494,437), or alternatively as obvious over Weitkamp in view of Jackson (3,829,064). The Examiner rejected claims 8, 9, 11 and 16-20 as obvious over Nickelsen (EP 1101936) in view of Boyer, or alternatively as obvious over Nickelsen in view of Jackson. The Examiner's rejections are respectfully traversed. These are the same rejections previously asserted by the Examiner.

Response to Arguments

Applicant previously argued that Weitkamp, Boyer and Nickelsen teach complete lifting systems with all the components connected together in a single structure, and thus teach away from the claimed subject matter. In response, the Examiner appears to contend that Weitkamp, Boyer or Nickelsen teach an alternative embodiment with a winch separate from a support structure may be employed. The Examiner does not provide any citations to a disclosure of such an alternative embodiment in the references. There does not appear to be any suggestion in the references of separating the winch from the boom or crane, as the case may be, or that the winch is usable on a vehicle after such separation. For example, each figure in Weitkamp illustrates a winch on an integrated crane; there is no showing of the use of a winch alone, or of a crane alone. Boyer, too, only discloses a winch that is integrated to the boom and does not contemplate any alternative configuration for the winch and boom. In Jackson, the winch is mounted on a moveable track assembly on the vehicle. See Jackson, Column 1:33-43. Thus, there is no suggestion in the references of an embodiment, for example, of "laying a hauling cable from the winch" (see claim 6), where the winch is separate from the crane or boom of the

reference. Similarly, the Examiner's argument that prior winches were hauled to wind power installations in vehicles does not mean such prior winches were "mounted" on those vehicles at the base of the installation, with a "hauling cable," and, for example, "without using a crane separate from the pylon to support the winch" (see claim 1).

Applicant previously argued Jackson was not intended to or suitable for lifting components, and would be inherently unstable if modified for use to lift components. In response, the Examiner contends that Jackson was cited to show that a winch can be transported on a vehicle, and that the claims do not make any specific requirements for the vehicle other than it being a transport vehicle. The Examiner is incorrectly ignoring the context of the claims, which do not recite "a vehicle" in isolation. For example, independent claim 1 recites, "at least one cable passage means in the region of the pylon head for passing therethrough a hauling cable from the winch, wherein the winch is mounted on a vehicle at the base of the wind power installation, without using a crane separate from the pylon to support the winch." Thus, claim 1 requires the vehicle to be at the base of the wind power installation, to have a winch mounted thereon, and also requires a hauling cable passing from the winch to a cable passage means.

Turning to the specifics, independent claim 1, as amended, recites, "[a] wind power installation comprising: a pylon having a head; a winch; at least one deflection roller; at least one cable passage means in the region of the pylon head for passing therethrough a hauling cable from the winch, wherein the winch is mounted on a vehicle at the base of the wind power installation, without using a crane separate from the pylon to support the winch; and a pod, wherein the at least one cable passage means is in the pod and is configured to pass through the hauling cable from the winch at the base of the wind power installation." Independent claim 6, recites, "[a] method of fitting/removing components of a wind power installation comprising: transporting a winch mounted on a transport vehicle to a base of the wind power installation, laying a hauling cable from the winch to at least one deflection roller in a region of a pylon head and further to a component to be fitted/removed, attaching the hauling cable to the component, and releasing and letting down or pulling up and fixing the component, wherein a crane separate from the pylon is not used to support the winch." Independent claim 8, as amended, recites, "[a] wind power installation, comprising: a pylon; a base; a pod; and means for moving an object

with respect to the pod, wherein the means for moving an object with respect to the pod is at least partially contained within the pod and includes: a winch mounted on a transport vehicle, wherein a crane separate from the pylon is not used to support the winch; a cable guide in the pod; an opening in the pod; and a cable coupled to the winch, wherein the cable guide is configured to guide the cable and the cable is configured to pass through the opening in the pod.” Independent claim 16, as amended, recites, “[a] wind power installation, comprising: a pylon; a base; a pod; a blade mount opening in the pod; a winch mounted on a transport vehicle, without using a crane; a cable coupled to the winch, wherein the cable is configured to pass through the blade mount opening in the pod; and a cable guide in the pod configured to guide the cable and having a deflection roller configured to support the cable.” Independent claim 20 recites, “[a] wind power installation, comprising: a pylon; a base; a pod; a cable guide in the pod; a blade mount opening in the pod; a winch mounted on a transport vehicle; and a cable coupled to the winch, wherein the cable guide in the pod is configured to guide the cable, the cable is configured to pass through the blade mount opening in the pod and the winch is configured to use the cable to lift and lower heavy components of the wind power installation without the use of a crane.”

Weitkamp, Alone or in Combination With Boyer, Does Not Render the Claims Obvious

The Examiner first relies on Weitkamp and Boyer. Weitkamp discloses a winch 60 which is permanently mounted to a pylon foundation. There is a single structure which comprises the winch, the foundation, the tower, the crane arms and its ends. See Figure 3 of Weitkamp. In Boyer, a winch is mounted on a boom of a host vehicle. Thus Weitkamp and Boyer both teach complete lifting systems with all the components connected together in a single structure, and thus both teach away from the claimed subject matter. In contrast, independent claims 1 and 6 are directed to systems in which the winch and the supporting structure are separate, and in which the winch is not supported by a crane separate from the pylon. One would not be motivated to combine Weitkamp and Boyer because there is no need in Weitkamp for the boom of Boyer (and no need in Boyer for the winch of Weitkamp), and because coupling the boom of Boyer to the winch of Weitkamp would be complicated, which is contrary to the simple structure of Weitkamp. Accordingly, Applicant submits that claims 1 and 6 are not rendered

obvious by Weitkamp, alone or in combination with Boyer. Claims 2-4 depend from claim 1, and claim 7 depends from claim 6, and are thus allowable at least by virtue of their dependencies, as well as because of the novel and non-obvious combinations claimed therein.

Applicant also notes that the Examiner has pointed to admitted prior art as teaching that it is well known to transport a winch to an installation for raising and lower components. The Examiner then reasons that it would have been obvious to use the winch of Boyer to raise and lower component into the wind power installation. The Examiner appears to be referring to the following portion of the description of the prior art:

Wind power installations have long been known. The considerable dimensions and weights of modern installations means that on the one hand components frequently have to be transported individually to the building site. There the components are then fitted together. In that respect in the meantime loads of 50 tons and more certainly have to be lifted.

On the other hand loads also have to be lifted to a considerable height of over 100 meters. Admittedly winches are known in wind power installations, but those winches are mostly disposed in the rear part of the pod of the wind power installation.

Substitute Spec. at page 1, lines 8-16. See also Original Spec. at page 1, lines 7-15.

This portion of the specification is not an admission that it was known to use a winch mounted on a transport vehicle to raise and lower components, as the Examiner appears to suggest. Further, as discussed in more detail above, Boyer discloses a complete lifting system on the vehicle. One would not be motivated to combine the boom of Boyer with the winch of Weitkamp. The dispute is not whether it was admittedly known to transport winches to wind power installations. Instead, the issue is whether it was admittedly known to leave the winch on the transport vehicle after transporting it and, while the winch remained on the transport vehicle, to use the winch to pull up or let down components of the wind power installation. It was not known, or admittedly known.

The Examiner also contends that the combination of Weitkamp and Boyer would be inherently capable of performing the method as claimed. Any such contention is respectfully traversed. Claim 1 recites "wherein the winch is mounted on a vehicle at the base of the wind power installation, without using a crane separate from the pylon to support the winch." Claim 6

recites, “transporting a winch mounted on a transport vehicle to a base of the wind power installation, ... wherein a crane separate from the pylon is not used to support the winch.” In Weitkamp, the winch is not mounted on a vehicle. In Boyer, the winch is mounted on the boom on the vehicle. Thus, contrary to the Examiner’s contention, neither the winch of Weitkamp nor the winch of Boyer satisfies the limitations of the claimed winch. In addition, inherency is not established by showing that a combination of references could be modified to perform a recited method. Thus, whether the combined references would be “capable” of performing a method as claimed (they are not) does not establish that it would have been obvious to combine the references and then further modify the combination to perform the recited method of claim 6.

In response to Applicant’s arguments, the Examiner argues that “completeness of the inventions disclosed in the prior art has no bearing on the rejections.” Applicant respectfully disagrees. When rendering an obviousness rejection, the Examiner is required to consider whether each reference as a whole teaches away from the claimed invention. A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Here, Weitkamp and Boyer both teach complete lifting systems with all the components connected together in a single structure, and thus both teach away from the claimed subject matter. In contrast, independent claims 1 and 6 are directed to systems in which the winch and the supporting structure are separate.

For example, one would not be motivated to combine Weitkamp with Boyer because doing so is inconsistent with the principals of operation of Weitkamp. Weitkamp’s improvement over the prior art was to move away from the winch-boom combination on a vehicle of Boyer, and instead permanently mount the winch and a crane to the windpower installation. Using Boyer’s boom mounted winch in Weitkamp necessarily means regressing to the state of the art before Weitkamp’s invention. Achieving the claimed invention would then require at least the further modification of splitting the boom and winch.

Weitkamp, Alone or in Combination With Jackson, Does Not Render the Claims Obvious

The Examiner next relies on Weitkamp and Jackson. The winch and vehicle of Jackson are designed for pulling or towing work. Jackson is not intended to or suitable for lifting components, and would be inherently unstable if modified for use to lift components. In particular, the components of a wind power installation can weigh between several tons and 20 twenty tons. The winch of Jackson would either separate from the vehicle, or the entire vehicle would be winched up the cable. In addition, Weitkamp already has a winch inside the pylon, and one would not be motivated to replace it with the inadequate winch of Jackson outside the pylon. Accordingly, Applicant submits that claims 1 and 6 are not rendered obvious by Weitkamp, alone or in combination with Jackson. Claims 2-4 depend from claim 1, and claim 7 depends from claim 6, and thus claims 2-4 and 7 are allowable at least by virtue of their dependencies, as well as because of the novel and non-obvious combinations claimed therein.

The Examiner's arguments regarding the allegedly admitted prior art is addressed above.

The Examiner also contends that the combination of Weitkamp and Jackson would be inherently capable of performing the method of claim 6. Any such contention is respectfully traversed. Claim 6 recites, "laying a hauling cable from the winch to at least one deflection roller in a region of a pylon head and further to a component to be fitted/removed, attaching the hauling cable to the component, and releasing and letting down or pulling up and fixing the component." The vehicle, frame and winch of Jackson would be inherently unsuitable for use in a windpower installation. For example, the winch of Jackson would be incapable of performing the reciting letting down or pulling up (see claim 6).

In response, the Examiner argues there are no limitations regarding the vehicle in the claims, and thus the argument that the vehicle of Jackson is unsuitable is irrelevant. Applicant respectfully disagrees as set forth above. The "vehicle" is not recited in isolation, but as part of a combination. The claims also recite limitations of the winch mounted on the vehicle, and the winch of Jackson is both unsuitable for the recited functions and configured to perform a very different task. Second, the Examiner relies on the alleged admission of prior art, which is addressed above. Third, the very different use to which the vehicle/winch/frame combination of Jackson was put is a factor to be considered when deciding whether one of skill in the art of

windpower installations would consider combining Jackson with Weitkamp. Fourth, the Examiner is required to consider whether the references as a whole teach away from claimed invention. Weitkamp and Jackson both teach complete structures for their respective purposes, thus both teach away from systems in which the winch and the supporting structure are separate. Nickelsen, Alone or in Combination With Boyer, Does Not Render the Claims Obvious

The Examiner next relies on Nickelsen in view of Boyer. Nickelsen and Boyer both disclose complete lifting systems, with all the components connected together in a single structure, and thus both teach away from the claimed subject matter. In contrast, independent claims 8 and 16 are directed to systems in which the winch and the supporting structure are separate, and in which the winch is not supported by a crane separate from the pylon. One would not be motivated to combine Nickelsen and Boyer because there is no need in Nickelsen for the boom of Boyer (and no need in Boyer for the winch of Nickelsen). Accordingly, Applicant submits that claims 8 and 16 are not rendered obvious by Nickelsen, alone or in combination with Boyer. Claims 11, 15, 17 and 18 depend from claim 8, and claim 19 depends from claim 16, and are thus allowable at least by virtue of their dependencies, as well as because of the novel and non-obvious combinations claimed therein. The Examiner's arguments regarding the allegedly admitted prior art, inherency, and the relevancy of the completeness of the cited references are addressed above.

With regard to claim 16, the Examiner noted that the host vehicle for the winch is not a crane. Applicant is not certain what the Examiner meant, but notes that in Boyer, the winch is mounted to a boom on the host vehicle.

Nickelsen, Alone or in Combination With Jackson, Does Not Render the Claims Obvious

The Examiner also relies on Nickelsen in view of Jackson. The winch and vehicle of Jackson are designed for pulling or towing work. Jackson is not intended to or suitable for lifting components, and would be inherently unstable if modified for use to lift components. In particular, the components of a wind power installation can weigh between several tons and 20 twenty tons. The winch of Jackson would either separate from the vehicle, or the entire vehicle would be winched up the cable. In addition, Nickelsen already has a winch, and one would not be motivated to replace it with the inadequate winch of Jackson. Accordingly, Applicant submits

that claims 8 and 16 are not rendered obvious by Nickelsen, alone or in combination with Jackson. Claims 11, 15, 17 and 18 depend from claim 8, and claim 19 depends from claim 16, and are thus allowable at least by virtue of their dependencies, as well as because of the novel and non-obvious combinations claimed therein.

Claim 20 is allowable over the cited references for reasons that will be apparent in view of the allowability of claims 8 and 16.

Claim 16 Is Supported by the Specification as Filed

The Examiner rejected claim 16 under 35 USC Section 112, first paragraph, as containing new matter. While the Examiner's rejection is respectfully traversed and appears to be based on semantics rather than any alleged failure to disclose the claimed subject matter in the specification, claim 16 has been amended and it is believed the amendment renders the Examiner's rejection moot. Specifically, the Examiner admitted that the specification discloses "not using a crane at all." Accordingly, the Examiner is respectfully requested to withdraw this basis for rejection.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
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